



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,075	10/20/2003	Toshifumi Masaki	1232-5178	4876
27123	7590	12/08/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P.			SUNDARARAMAN, VIKRAM P	
3 WORLD FINANCIAL CENTER			ART UNIT	
NEW YORK, NY 10281-2101			PAPER NUMBER	

3736

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/690,075

Applicant(s)

MASAKI, TOSHIFUMI

Examiner

Vikram P. Sundararaman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**\*DETAILED ACTION**

***Information Disclosure Statement***

1. The information disclosure statement filed on October 20, 2003, with respect to Foreign Patents and Non-Patent Literature document sections, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

3. As to Claims 1, 2, 3, 5, and 8 the applicant fails to define in the specification what exactly in full, clear and exact terms what the reference value is. For the purposes of compact prosecution, the examiner will examine the following claims based on the merits as best understood. As such, the phrase "reference value" is taken to refer to the determination and storage of "the brightness of the bright points based on the image

Art Unit: 3736

data of the anterior ocular segment at the time of alignment" (Page 14, Line12) and the calculated error level and warning level thereof.

4. Claims 1 - 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. As to Claims 1, 5 and 8, for the purposes of compact prosecution the examiner will consider the claims based on the merits as best understood. As such, the examiner understands that the determination of reliability and/or validity is dependent on calculation of error level and warning level and some comparison. The applicant has only describes the calculation of the error level and warning level as "calculated using a conversion formula prepared in advance," (page 14, Line 15). The examiner is unable to ascertain a specific conversion formula, as one is not given. Furthermore it is not described how and by what method this conversion is applied.

6. As to Claim 2, it is unclear how the reference value is changed reflected light quantity of the alignment light flux from the eye to be examined received by said alignment detection means and where this changed value is stored and how this changed value is used.

7. As to Claim 3, it is unclear how the reference value is changed based on a peak value of the alignment light flux reflected from the eye to be examined detected by said

Art Unit: 3736

alignment detection means and where this changed value is stored and how this changed value is used.

8. As to Claim 6, measurement of intraocular pressure based on the data of the inner pressure signal is described as "[calculated]... using a conversion formula prepared in advance." The examiner is unable to ascertain the conversion formula, as one is not provided. Furthermore it is not described how and by what method this conversion is applied.

#### ***Allowable Subject Matter***

9. Claims 1-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action. Claims 1-8 define over prior art because applicant demonstrates novelty to comparing an output of intraocular pressure measurement light receiving means and a reference value to determine reliability; wherein the reference value is changed with respect to an alignment detection means. While it is understood that there is novelty in establishing and changing a reference value, thereby accounting for differences in corneal reflectance, the applicant must still provide enabling features of the invention before allowance is granted on this application.

#### ***Conclusion***

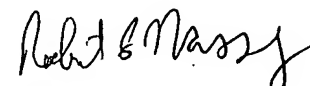
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vikram P. Sundararaman whose telephone number is 571.272.3351. The examiner can normally be reached on M-F, 730am-4pm.

Art Unit: 3736

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VPS

  
ROBERT L. NASSER  
PRIMARY EXAMINER